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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,308

03/18/2004

Patricia J. Horst

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EXAMINER

KYLE, MICHAEL J

ART UNIT

PAPER NUMBER

3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/803,308

Applicant(s)

HORST ET AL.

Examiner

Michael J. Kyle

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,5,6,9,11,13,14,17,19,20 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,6,9,11,13,14,17,19,20,30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 3, 5, 6, 9 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2113993 (“GB ‘993”). GB ‘993 discloses an apparatus for securing a floor covering to an underlying substrate, where the underlying substrate includes a layer of pile extending upward from a backing, the apparatus comprising a substantially flat and planar central base member (1) adapted to be placed between a floor covering and the underlying substrate, where the central base member (1) has an upper surface (5) that is adapted to engage the floor covering, and a lower surface (2) having one or more downwardly extending spikes adapted to pass through the layer of pile and engage the backing of the underlying substrate. Examiner notes that the “adapted for” clause of this claim is a functional recitation of the claimed structure. An apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114). As long as the prior art is capable of performing the claimed function, then it is considered to meet the limitations of the claim. In this case, the spike (3) of GB ‘993 is capable of passing through a layer of pile and engaging a backing of the substrate.
3. With respect to claims 5 and 6, GB ‘993 discloses the upper surface to include an adhesive that covered by a removable protective membrane (8).

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4. With respect to claim 9, GB '993 shows a downwardly extending spike that is capable of penetrating completely through the backing of an underlying substrate. Examiner notes that on page 2, lines 32-40, GB '993 discusses the possibility of the spikes being non-rounded, and the gripper being made of a rigid material. These characteristics would further enable the spike to penetrate through a backing.

5. With respect to claim 30, GB '993 discloses an apparatus comprising a substantially flat and planar central base member (1) having an upper surface adapted to engage a rug, and a single spike (3) capable of penetrating completely through a pile layer and backing. Examiner notes that as long as the prior art is capable of performing the claimed function (i.e. "penetrating completely through...") then it is considered to meet the limitations of the claim. Additionally, because each spike (3) is an individual piece, each spike is considered to be a single spike.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11, 13, 14, 17, 19, 20, and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '993 in view of Carr (U.S. Patent No. 1,731,704). GB '993 fails to disclose a barb on the spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5). The downwardly extending spike includes a barb in the form of a thread. Merriam-Webster's Collegiate Diction 10<sup>th</sup> Edition defines a "barb"

as “a sharp projection extending backward”. In this case, the outer surface of the thread is a sharp projection that extends backward. Carr uses this thread, or barb, to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB ‘993 as taught by Carr, such that the spikes include a thread, or barb, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

8. With respect to claims 13 and 14, GB ‘993 discloses the central base member to include an adhesive (5) with a removable protective membrane (8).

9. With respect to claim 17, GB ‘993 fails to show a thread on a single downwardly extending spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5) having a thread. Carr uses this thread to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB ‘993 as taught by Carr, such that the spikes include a thread, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

10. With respect to claims 19 and 20, GB ‘993 discloses the central base member to include an adhesive (5) with a removable protective membrane (8) that is peeled off for attachment of the upper surface (6) of the central base member to a lower surface of a floor covering.

11. With respect to claim 31, GB ‘993 fails to disclose a barb on the spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5). The downwardly extending spike includes a barb in the form of a thread. Merriam-Webster’s Collegiate Diction 10<sup>th</sup> Edition defines a “barb” as “a sharp projection extending backward”. In this case, the outer surface of the thread is a sharp projection that extends

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backward. Carr uses this thread, or barb, to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB '993 as taught by Carr, such that the spikes include a thread, or barb, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

12. With respect to claim 32, GB '993 fails to show a thread on a single downwardly extending spike. Carr teaches a fastener including a central base member (B) and a downwardly extending spike (see Figures 2 and 5) having a thread. Carr uses this thread to positively secure the fastener to the floor. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify GB '993 as taught by Carr, such that the spikes include a thread, which provides a positive fastening arrangement to more securely fasten the gripper to the floor.

13. With respect to claims 33 and 34, Carr discloses grasping elements or torque receiving elements (inherent) to apply a torque to the apparatus. Without such elements, the threaded portion of Carr would not be able to be threaded into the floor. Thus, gripping or torque receiving element must necessarily be present in Carr to screw the threaded portion into the floor.

### *Response to Arguments*

14. Applicant's arguments filed September 6, 2006, have been fully considered but they are not persuasive. Applicant argues that GB '993 teaches away from the claimed invention. Examiner respectfully disagrees, and notes that the rejection of claim 3 is under section 102, and is based on anticipation. GB '993 meets each and every structural limitation of the claim. Applicant bases their argument on the functional limitation that the claimed structure is adapted

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to pass through a layer of pile and engage a backing. Examiner notes that an apparatus must be distinguished from the prior art in terms of structure rather than function (MPEP 2114).

Additionally, while GB '993 discusses the spikes to bed into or grip a layer of pile, this is only a discussion of their intended use. Depending on the rigidity and form of the spikes, examiner asserts they are capable of passing through the pile and engaging a backing. There are no structural limitations in the claim that differentiate the instant invention from the prior art.

15. Applicant argues that GB '993 discloses the use of only a plurality of spikes, and not a single spike as claimed. Examiner asserts that the claim limitation of "a single" spike does not preclude prior art showing more than one spike from meeting the claim limitation. The term "a single" does not exclude prior art showing more than one spike. This term is read similar to "a", "an", or "one". As long as the prior art has at least the claimed structure, it meets the limitation. There are no exclusionary terms such as "only" in the claims.

16. Applicant argues that the fact that a certain result may occur or be present in the prior art is not sufficient to establish inherency. Examiner notes that inherency was not relied in the rejections where it was stated that the prior art is "capable of" performing claimed functions. MPEP 2114 requires that an apparatus be distinguished from the prior art in terms of structure, not function.

17. Applicant argues that the combination of GB '993 and Carr is a result of impermissibly working backward from the applicant's disclosure and that the references teach away from another. However, these arguments do not specifically address the elements of the rejection made by the examiner and appear to be nothing more than an allegation of patentability.

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18. With regard to applicant's argument regarding the definition of a "barb" on page 13 of the response, examiner notes that a barb, narrowly construed, as applicant appears to support, is shown only by the non-elected species of figure 5 and figure 12. The elected species V, shown in figure 9, shows only a thread. It is not clear if applicant's argument is an admission that a thread is not barb. If this is an admission of such, then all claims referring to a barb should be withdrawn from consideration as being directed to a non-elected species.

19. With respect to claims 13, 14, 19, and 20, applicant argues that the reference numbers cited do not appear in Carr. Examiner notes the error, and has provided a corrected version above. The reference numbers refer to the elements of GB '993, not Carr. In correcting this issue, a new grounds of rejection has been raised that was not necessitated by amendment. For this reason, this Office Action is non-final.

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

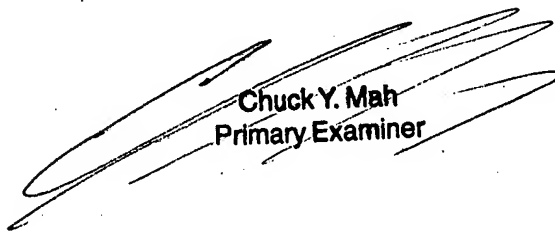
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mk



Chuck Y. Mah  
Primary Examiner